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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/708,883	11/07/2000	L. Carlton Brown JR.	06969-022320US	2938

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EXAMINER

COSIMANO, EDWARD R

ART UNIT	PAPER NUMBER
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3629

DATE MAILED: 07/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/708,883

Applicant(s)BROWN ET AL. **Examiner**

Edward R. Cosimano

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 November 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-60 is/are pending in the application.
- 4a) Of the above claim(s) none is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-60 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 November 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>4/9/01 & 6/11/02</u> . | 6) <input type="checkbox"/> Other: _____ |

1. Applicant should note the changes to patent practice and procedure:
 - A) effective December 01, 1997 as published in the Federal Register, Vol 62, No. 197, Friday October 10, 1997;
 - B) effective November 07, 2000 as published in the Federal Register, Vol 65, No. 54603, September 08, 2000; and
 - C) Amendment in revised format, Vol. 1267 of the Official Gazette published February 25, 2003.
2. Applicant's claim for the benefit of an earlier filing date under 35 U.S.C. § 119(e) and 35 U.S.C. § 120 is acknowledged.
3. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. § 120/119(e) as follows:
 - A) The second application (which is called a continuing application) must be an application for a patent for an invention which is also disclosed in the first application (the parent or provisional application); the disclosure of the invention in the parent application and in the continuing application must be sufficient to comply with the requirements of the first paragraph of 35 U.S.C. § 112. See *In re Ahlbrecht*, 168 USPQ 293 (CCPA 1971).
 - B) This application is claiming the benefit of a prior filed nonprovisional application under 35 U.S.C. § 120, § 121, or § 365(c). Copendency between the current application and the prior application is required.
- 3.1 If applicant desires priority under 35 U.S.C. 120 based upon a previously filed application no 09/611,375 (see declaration), specific reference to the earlier filed application must be made in the instant application. For benefit claims under 35 U.S.C. 120, 121 or 365(c), the reference must include the relationship (i.e., continuation, divisional, or continuation-in-part) of the applications. This should appear as the first sentence of the specification following the title, preferably as a separate paragraph unless it appears in an application data sheet. The status of nonprovisional parent application(s) (whether patented or abandoned) should also be included. If a parent application has become a patent, the expression "now Patent No. ____" should follow the filing date of the parent application. If

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a parent application has become abandoned, the expression "now abandoned" should follow the filing date of the parent application.

3.2 If the application is a utility or plant application filed under 35 U.S.C. 111(a) on or after November 29, 2000, the specific reference must be submitted during the pendency of the application and within the later of four months from the actual filing date of the application or sixteen months from the filing date of the prior application. If the application is a utility or plant application which entered the national stage from an international application filed on or after November 29, 2000, after compliance with 35 U.S.C. 371, the specific reference must be submitted during the pendency of the application and within the later of four months from the date on which the national stage commenced under 35 U.S.C. 371(b) or (f) or sixteen months from the filing date of the prior application. See 37 CFR 1.78(a)(2)(ii) and (a)(5)(ii). This time period is not extendable and a failure to submit the reference required by 35 U.S.C. 119(e) and/or 120, where applicable, within this time period is considered a waiver of any benefit of such prior application(s) under 35 U.S.C. 119(e), 120, 121 and 365(c). A priority claim filed after the required time period may be accepted if it is accompanied by a grantable petition to accept an unintentionally delayed claim for priority under 35 U.S.C. 119(e), 120, 121 and 365(c). The petition must be accompanied by (1) the reference required by 35 U.S.C. 120 or 119(e) and 37 CFR 1.78(a)(2) or (a)(5) to the prior application (unless previously submitted), (2) a surcharge under 37 CFR 1.17(t), and (3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2) or (a)(5) and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional. The petition should be addressed to: Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450.

3.3 It is noted that U.S. application serial number 09/611,375 was abandoned by the patent office as an incomplete application, therefore that application never existed and hence there can not be any period of copendency as required.

4. The use of various trademark(s), for example: "Internet Explorer", "Microsoft", "Netscape Navigator", "Windows NT", have been noted in the paragraph located:

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A) at page 10, lines 15-29, "As stated above, ... Internet Explorer browser program provided by Microsoft Corporation, the Netscape Navigator browser provided by Netscape Corporation, and ... then be viewed by the user using the browser."; and

B) at page 26, lines 7-22, "According to an embodiment ... Windows NT ... Windows NT ... schemes/algorithms may also be used by web server 702."

Any trademarks should be capitalized wherever they appear and be accompanied by the generic terminology.

4.1 Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

5. The drawings are objected to because

A) the following errors have been noted in the drawings:

(1) The drawings are objected to as failing to comply with 37 CFR § 1.84(p)(5) because they include the following reference sign(s) not mentioned in the description, note:

(a) printer 112-1 and 112-2 of fig. 1 as these features are described in the paragraphs located:

(i) between page 8, line 31, and page 9, line 6, "The present invention ... printers 112 ... and other peripheral devices (not shown) such as a weighing scale."; and

(ii) at page 9, lines 7-22, "Communication network 108 provides ... printers 112 ... may also be coupled to user systems 104.".

(b) servers 704-1 & 704-2 and modules 706-1 & 706-2 of fig. 7 as these features are described in the paragraphs located:

(i) between page 19, line 22, and page 22, line 32, "Fig. 7 depicts an expanded block ... server 702 and to PSDM server 704 via an ODBC interface.";

(ii) between page 25, line 32, and page 26, line 22, "If it is determined in step 808 ... schemes/algorithms may also be used by web server 702.";

(iii) between page 27, line 23, and page 31, line 33, "Referring back to Fig. 8, after ... may be used for this field for a DSA digital signature."; and

(iv) between page 34, line 8, and page 35, line 25, "Fig. 10 is a simplified flowchart ... then continues with step 1010 as described above.".

(c) step 812 of fig. 8 as this feature is described in the paragraph located between page 25, line 32, and page 26, line 6, "If it is determined in step 808 ... to distribute the work among PSDM servers 704.";

(d) ARs 906-1, 906-2, 906-3, 906-4 & 906-n and DRs 908-1, 908-2, 908-3, 908-4 & 908-n of fig. 9 as these features are described in the paragraphs located at page 33, lines 16-33, "Fig. 9 depicts relationships ... DR value 908 of the MPSD resource being funded. The summation of the ARs 906 and DRs 908 ... DR value 908 and added to the MPSD resource's AR value 906. A ... equations provide mathematical representations of the relationships:".

(2) The drawings are objected to as failing to comply with 37 CFR § 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description, note:

(a) printer 112 of fig. 1 as this feature is described in the paragraphs located:

(i) between page 8, line 31, and page 9, line 6, "The present invention ... printers 112 ... and other peripheral devices (not shown) such as a weighing scale."; and

(ii) at page 9, lines 7-22, "Communication network 108 provides ... printers 112 ... may also be coupled to user systems 104."

(b) servers 704 and modules 706 of fig. 7 as these features are described in the paragraphs located:

(i) between page 19, line 22, and page 22, line 32, "Fig. 7 depicts an expanded block ... server 702 and to PSDM server 704 via an ODBC interface.";

(ii) between page 25, line 32, and page 26, line 22, "If it is determined in step 808 ... schemes/algorithms may also be used by web server 702.";

(iii) between page 27, line 23, and page 31, line 33, "Referring back to Fig. 8, after ... may be used for this field for a DSA digital signature."; and

(iv) between page 34, line 8, and page 35, line 25, "Fig. 10 is a simplified flowchart ... then continues with step 1010 as described above."

(c) ARs 906 and DRs 908 of fig. 9 as these features are described in the paragraphs located at page 33, lines 16-33, "Fig. 9 depicts relationships ... DR value 908 of the MPSD resource being funded. The summation of the ARs 906 and DRs 908 ... DR value 908 and added to the MPSD resource's AR value 906. A ... equations provide mathematical representations of the relationships:".

5.1 A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

5.2 Applicant is required to submit a proposed drawing correction in reply to this Office action. However, formal correction of the noted defect may be deferred until after the

examiner has considered the proposed drawing correction. Failure to timely submit the proposed drawing correction will result in the abandonment of the application.

6. The disclosure is objected to because of the following informalities:

A) applicant must update:

(1) the continuing data on page 1, and

(2) the application data in the paragraphs located:

(a) between page 1, line 10, and page 2, line 30, "The present application claims ... Paper Using A Communications Network" (Attorney Docket No. 006969-022220175).";

(b) at page 18, lines 16-20, "The different features U.S. Application No. 09/611,375 filed July 7, 2000, the entire disclosure of which is herein incorporated by reference for all purposes.";

with the current status of each of the referenced applications, e.g., --now abandoned--, or --now patent #?--, or --which is abandoned and now serial number #?--, etc.

B) as required by 37 CFR § 1.84(p(5)) and 37 CFR § 1.121(e) the specification lacks an explicit reference to the nature of:

(1) reference legend(s):

(a) printer 112-1 & 112-2 of fig. 1 as described in the paragraphs located:

(i) between page 8, line 31, and page 9, line 6, "The present invention ... printers 112 ... and other peripheral devices (not shown) such as a weighing scale."; and

(ii) at page 9, lines 7-22, "Communication network 108 provides ... printers 112 ... may also be coupled to user systems 104.".

(b) servers 704-1 & 704-2 and modules 706-1 & 706-2 of fig. 7 as these features are described in the paragraphs located:

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(i) between page 19, line 22, and page 22, line 32, "Fig. 7 depicts an expanded block ... server 702 and to PSDM server 704 via an ODBC interface.";

(ii) between page 25, line 32, and page 26, line 22, "If it is determined in step 808 ... schemes/algorithms may also be used by web server 702.";

(iii) between page 27, line 23, and page 31, line 33, "Referring back to Fig. 8, after ... may be used for this field for a DSA digital signature."; and

(iv) between page 34, line 8, and page 35, line 25, "Fig. 10 is a simplified flowchart ... then continues with step 1010 as described above.";

(c) step 812 of fig. 8 as this feature is described in the paragraph located between page 25, line 32, and page 26, line 6, "If it is determined in step 808 ... to distribute the work among PSDM servers 704."; and

(d) ARs 906-1, 906-2, 906-3, 906-4 & 906-n and DRs 908-1, 908-2, 908-3, 908-4 & 908-n of fig. 9 as this figure is described in the paragraphs located at page 33, lines 16-33, "Fig. 9 depicts relationships ... DR value 908 of the MPSD resource being funded. The summation of the ARs 906 and DRs 908 ... DR value 908 and added to the MPSD resource's AR value 906. A ... equations provide mathematical representations of the relationships:".

In this regard, it is noted that merely mentioning either a feature or a number with out mentioning the device or operation or number or feature relies on the drawing to provide support for the disclosure and not to aid in the understanding of the invention, as is the purpose of the drawings (37 CFR § 1.81(a,b)).

C) the following errors have been noted in the specification:

(1) as can be seen in fig. 1 and from the context of the paragraphs located between page 8, line 31, and page 11, line 7, "The present invention ... of PVS 102, or combinations thereof.", at line 5 of the between page 8, line 31, and page 9, line 6, "The present invention ... systems 104-1 and 104-2 ... and other peripheral devices (not shown) such as a weighing scale.", the reference to "systems 104-1 and 104-2" should be -- systems 104-1 and 104-2, herein after system 104,--.

(2) as can be seen in fig. 1 and from the context of the paragraphs located:

(a) between page 8, line 31, and page 9, line 6, "The present invention ... printers 112 ... and other peripheral devices (not shown) such as a weighing scale."; and

(b) at page 9, lines 7-22, "Communication network 108 provides ... printers 112 ... may also be coupled to user systems 104."; each reference to "printers 112" should be --printers 112-1 and 112-2--.

(3) as can be seen in fig. 1 and from the context of the paragraph located at page 9, lines 7-22, "Communication network 108 provides ... links. Communications links 18 may ... may also be coupled to user systems 104.", at line 4 of this paragraph "18" should be --108--.

(4) as can be seen in fig. 7 and from the context of the paragraph located:

(a) between page 19, line 22, and page 22, line 32, "Fig. 7 depicts an expanded block ... server 702 and to PSDM server 704 via an ODBC interface.";

(b) between page 25, line 32, and page 26, line 22, "If it is determined in step 808 ... schemes/algorithms may also be used by web server 702.";

(c) between page 27, line 23, and page 31, line 33, "Referring back to Fig. 8, after ... may be used for this field for a DSA digital signature."; and

(d) between page 34, line 8, and page 35, line 25, "Fig. 10 is a simplified flowchart ... then continues with step 1010 as described above.";

at lines 3-4 of the paragraph located between page 19, line 22, and page 20, line 2, "Fig. 7 depicts an ... postal security device module (PSDM) servers 704 (with associated cryptographic modules 706), ... other variations, modifications, and alternatives.", "postal security device module (PSDM) servers 704 (with associated cryptographic modules 706)" should be - postal security device module (PSDM) servers 704-1 and 704-2, herein after 704, (with associated cryptographic modules 706-1 and 706-2, herein after 706)--.

Appropriate correction is required.

7. The specification and drawings have not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification or drawings. Applicant should note the requirements of 37 CFR § 1.74, § 1.75, § 1.84(o,p(5)), § 1.121(a)-1.121(f) & § 1.121(h)-1.121(i).

8. 35 U.S.C. § 101 reads as follows:

"Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title".

8.1 Claims 41-60 are rejected under 35 U.S.C. § 101 because the invention as claimed is directed to non-statutory subject matter.

8.1.1 The instant claims recite a system/device, (claims 41-60), which has a disclosed practical application in the technological arts, and which does not merely define either a computer program, a data structure, non-functional descriptive material, (i.e. mere data) or a natural phenomenon. Hence, the instant claims merely define device that contains a data

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structure comprising series of steps that as claimed could be but are not necessarily to be performed on a computer.

8.1.2 It is further noted that applicant has not recited a specific machine since the operations recited in the claim are merely to illustrate the operations of the instant invention since these operations are not in fact implemented by a processor/computer. Hence, applicant envisions the invention as recited in claims 41-60 as a disembodied storage device, i.e. memory, that stores a computer program as a non-functional data structure. Such a disembodied storage device is not a specific machine because:

A) it is not associated with a computer in such a way as to cause the computer to operate in a specific manner, (note In re Beauregard 35 USPQ2d 1383 (CAFC 1995) and the associated claims of U.S. Patent 5,710,578); and

B) a memory device alone can not perform the functions recited within the claims.

Therefore, the recited disembodied storage device, which itself can not perform the functions recited within the claims as the invention, is inoperative and lacks utility for the purpose of the invention.

8.1.3 In view of the above, the invention recited in claims 41-60, merely describes an abstract idea of a disembodied storage device, i.e. memory, that stores a computer program as a non-functional data structure, since a disembodied storage device by itself can not produce a concrete and tangible result by performing the functions recited within the claims as the invention (State Street Bank & Trust Co. v. Signature Financial Group Inc. 47 USPQ2d 1596 (CAFC 1998)). Hence, claims 41-60 do not have a claimed practical application, since the disembodied storage device is inoperative and therefore lacks utility for the purpose of the invention.

8.1.4 Nonfunctional descriptive material cannot render nonobvious an invention that would have otherwise been obvious. Cf. In re Gulack, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) (when descriptive material is not functionally related to the substrate, the descriptive material will not distinguish the invention from the prior art in terms of patentability). Common situations involving nonfunctional descriptive material are:

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- a computer that differs from the prior art solely with respect to nonfunctional descriptive material that cannot alter how the machine functions (i.e., the descriptive material does not reconfigure the computer), or

- a process that differs from the prior art only with respect to nonfunctional descriptive material that cannot alter how the process steps are to be performed to achieve the utility of the invention.

8.1.5 Hence, claims 41-60 are directed to an inoperative abstract idea that is non-statutory subject matter.

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

- (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

- (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

- (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

- (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements

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of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

9.1 Claims 1-5, 17-19, 21-25, 37-39, 41-45 & 57-59 are rejected under 35 U.S.C. § 102(b) as being clearly anticipated by either Brookner et al (WO 98/13790) or Shah et al (5,822,738) or Kara (5,822,739) or Gravell et al (WO 98/57303) or Lee et al (EP 0927960) or Brasington et al (5,923,406) or Sansone (5,978,781).

9.2 Claims 1-5, 17-19, 21-25, 37-39, 41-45 & 57-59 are rejected under 35 U.S.C. § 102(a) as being clearly anticipated by either Whitehouse (6,005,945) or Heiden et al (6,141,645).

9.3 Claims 1-5, 17-19, 21-25, 37-39, 41-45 & 57-59 are rejected under 35 U.S.C. § 102(e) as being clearly anticipated by either Shah et al (2003/0078893) or Beckstrom et al (6,594,374).

9.4 In regard to claims 1-5, 17-19, 21-25, 37-39, 41-45 & 57-59, either Brookner et al ('790) or Shah et al ('738) or Kara ('739) or Gravell et al ('303) or Lee et al ('960) or Brasington et al ('406) or Sansone ('781) or Whitehouse ('945) or Heiden et al ('645) or Shah et al ('893) or Beckstrom et al ('374), in the environment of computerized postage metering systems discloses a secured metering device (SMD) that has been licensed by the Postal Authority to store and dispenses postage and is used by a postage vendor to dispense postage to customers of the vendor. When a customer, that is located remotely from the SMD, at the customer's general purpose PC desires to print postage on an item of mail using the user's general purpose printer, then the user at the PC would create a request for postage. Where the request for postage would include at least an identification of the customer, the originating location, the postage value, class of service, destination zip code, piece count or transaction number, an indication of the method of payment, as well as any other information required to

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determine the correct postage for an item of mail. Next, the generated request for postage is transmitted to remotely located SMD via a suitable communications network, where SMD uses the transmitted information to:

A) validate the request and whether there are sufficient funds for the requested postage value to be printed;

B) account for the requested postage in a single general account or an individual account for the user; and

C) to generate a print file of a valid postage indicia that includes encode information as evidence of postage payment.

The print file is then transmitted back to the identified user at the PC via a suitable communications network where the postage is printed on item of mail by user using the user's printer. The above process is repeated for each user at a PC that is requesting to print postage on an item of mail.

9.4.1 It is noted that the user of either Kara ('739) or Whitehouse ('945) gains access to the system by using a ID and password.

10. The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

(c) Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

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10.1 Claims 6, 26 & 46 are rejected under 35 U.S.C. § 103(a) as being unpatentable over either Brookner et al (WO 98/13790) or Shah et al (5,822,738) or Kara (5,822,739) or Gravell et al (WO 98/57303) or Lee et al (EP 0927960) or Brasington et al (5,923,406) or Sansone (5,978,781) or Whitehouse (6,005,945) or Heiden et al (6,141,645) or Shah et al (2003/0078893) or Beckstrom et al (6,594,374) as applied above to claims 1-5, 17-19, 21-25, 37-39, 41-45 & 57-59 and further in view of alternative forms of payment.

10.1.1 In regard to claims 6, 26 & 46 and the use of credit card information, since the systems of either Brookner et al ('790) or Shah et al ('738) or Kara ('739) or Gravell et al ('303) or Lee et al ('960) or Brasington et al ('406) or Sansone ('781) or Whitehouse ('945) or Heiden et al ('645) or Shah et al ('893) or Beckstrom et al ('374) require that the postage to be applied by the user be paid for by the user in advance of the postage being printed, it would have been obvious to one of ordinary skill at the time of the invention that the systems of either Brookner et al ('790) or Shah et al ('738) or Kara ('739) or Gravell et al ('303) or Lee et al ('960) or Brasington et al ('406) or Sansone ('781) or Whitehouse ('945) or Heiden et al ('645) or Shah et al ('893) or Beckstrom et al ('374) could be modified to use any suitable form of payment for the requested postage that the operator of the systems of either Brookner et al ('790) or Shah et al ('738) or Kara ('739) or Gravell et al ('303) or Lee et al ('960) or Brasington et al ('406) or Sansone ('781) or Whitehouse ('945) or Heiden et al ('645) or Shah et al ('893) or Beckstrom et al ('374) would accept for payment.

10.2 Claims 7-16, 20, 27-36, 40, 47-56 & 60 are rejected under 35 U.S.C. § 103(a) as being unpatentable over either Brookner et al (WO 98/13790) or Shah et al (5,822,738) or Kara (5,822,739) or Gravell et al (WO 98/57303) or Lee et al (EP 0927960) or Brasington et al (5,923,406) or Sansone (5,978,781) or Whitehouse (6,005,945) or Heiden et al (6,141,645) or Shah et al (2003/0078893) or Beckstrom et al (6,594,374) as applied above to claims 1-6, 17-19, 21-26, 37-39, 41-46 & 57-59 and further in view of In re Dulberg, 129 U.S.P.Q. 348 @ 349 (CCPA, 1965) or In re Harza, 124 U.S.P.Q. 378 @ 380 (CCPA, 1960).

10.2.1 In regard to:

A) the host system comprising multiple SMD servers of claims 7, 20, 27, 40, 47 & 60;

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B) the list of available SMD servers of claims 8, 28 & 48; and

C) the selection of an available server of claims 8, 9, 15, 20, 28, 29, 35, 40, 48, 49, 55 & 60;

since the systems of either Brookner et al ('790) or Shah et al ('738) or Kara ('739) or Gravell et al ('303) or Lee et al ('960) or Brasington et al ('406) or Sansone ('781) or Whitehouse ('945) or Heiden et al ('645) or Shah et al ('893) or Beckstrom et al ('374) teach that the SMD may be one device that accounts for the postage dispensed from a single account or from multiple accounts, that is one account for each customer, it would have been obvious to one of ordinary skill at the time of the invention that the systems of either Brookner et al ('790) or Shah et al ('738) or Kara ('739) or Gravell et al ('303) or Lee et al ('960) or Brasington et al ('406) or Sansone ('781) or Whitehouse ('945) or Heiden et al ('645) or Shah et al ('893) or Beckstrom et al ('374) could be modified to use multiple SMD servers, because whether one or a plurality of SMD servers are used does not change the function provided by each of the individual SMD servers to a particular customer, for as the Court has stated it is not invention to merely make duplicate parts separable without unexpected results if access to something is desirable, (see In re Dulberg, 129 U.S.P.Q. 348 @ 349 (CCPA, 1965) and In re Harza, 124 U.S.P.Q. 378 @ 380 (CCPA, 1960)).

10.2.2 Further in this regard, the systems of either Brookner et al ('790) or Shah et al ('738) or Kara ('739) or Gravell et al ('303) or Lee et al ('960) or Brasington et al ('406) or Sansone ('781) or Whitehouse ('945) or Heiden et al ('645) or Shah et al ('893) or Beckstrom et al ('374) would require a list of available SMD servers in order for the systems of either Brookner et al ('790) or Shah et al ('738) or Kara ('739) or Gravell et al ('303) or Lee et al ('960) or Brasington et al ('406) or Sansone ('781) or Whitehouse ('945) or Heiden et al ('645) or Shah et al ('893) or Beckstrom et al ('374) to provide postage to any particular customer, where the particular SMD server used to supply postage to a particular customer would be selected based on the availability of any particular SMD server to provide postage to the requesting customer.

10.2.3 In regard to using cryptology when generating a postage indicia at the request of a customer of claims 10, 30 & 50, it is noted that the indicia generated by the systems of either

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Brookner et al ('790) or Shah et al ('738) or Kara ('739) or Gravell et al ('303) or Lee et al ('960) or Brasington et al ('406) or Sansone ('781) or Whitehouse ('945) or Heiden et al ('645) or Shah et al ('893) or Beckstrom et al ('374) include the use of encrypted validation information, that is a digital signature, and hence would include the use of a cryptographic module to perform this function.

10.2.4 In regard to recharging/refunding of funds to a SMD server of claims 11, 31 & 51, it is noted that the systems of either Brookner et al ('790) or Shah et al ('738) or Kara ('739) or Gravell et al ('303) or Lee et al ('960) or Brasington et al ('406) or Sansone ('781) or Whitehouse ('945) or Heiden et al ('645) or Shah et al ('893) or Beckstrom et al ('374) include the use of refundable SMD devices, that may receive additional fund when the stored funds are low, hence it would have been obvious to one of ordinary skill at the time of the invention that the systems of either Brookner et al ('790) or Shah et al ('738) or Kara ('739) or Gravell et al ('303) or Lee et al ('960) or Brasington et al ('406) or Sansone ('781) or Whitehouse ('945) or Heiden et al ('645) or Shah et al ('893) or Beckstrom et al ('374) would include the function of recharging/refunding an SMD server when there are low or insufficient funds to accomplish the task or generating postage indicia for a requesting customer.

10.2.5 In regard to accounting functions of claims 12-14, 20, 32-34, 40, 52-54 & 60, it is noted that the systems of either Brookner et al ('790) or Shah et al ('738) or Kara ('739) or Gravell et al ('303) or Lee et al ('960) or Brasington et al ('406) or Sansone ('781) or Whitehouse ('945) or Heiden et al ('645) or Shah et al ('893) or Beckstrom et al ('374) include the function of accounting for the postage dispensed at the request of the customer before generating the postage indicia. Where, each account stored in the SMD as would be understood by one of ordinary skill at the time of the invention each customer account would include at least:

A) a descending register that stores the amount of funds available for printing at the request of the customer, and the value stored in this register is decreased by the amount of postage dispensed during each request of the customer;

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B) a ascending register that stores the total amount of funds that have been dispensed at the request of the customer, and the value stored in this register is increased by the amount of postage dispensed during each request of the customer.

Hence, SMD servers/devices, of either Brookner et al ('790) or Shah et al ('738) or Kara ('739) or Gravell et al ('303) or Lee et al ('960) or Brasington et al ('406) or Sansone ('781) or Whitehouse ('945) or Heiden et al ('645) or Shah et al ('893) or Beckstrom et al ('374) would include the function of properly account for the postage dispensed at the request of any customer.

10.2.6 In regard to using the internet as the communications link between the customer and the SMD servers with the associated use of web browser of claims 16, 36 & 56, it is noted that the systems of either Brookner et al ('790) or Shah et al ('738) or Kara ('739) or Gravell et al ('303) or Lee et al ('960) or Brasington et al ('406) or Sansone ('781) or Whitehouse ('945) or Heiden et al ('645) or Shah et al ('893) or Beckstrom et al ('374) require the use of a communications link between the customer's PC and the SMD servers at the vendor, hence it would have been obvious to one of ordinary skill at the time of the invention that the systems of either Brookner et al ('790) or Shah et al ('738) or Kara ('739) or Gravell et al ('303) or Lee et al ('960) or Brasington et al ('406) or Sansone ('781) or Whitehouse ('945) or Heiden et al ('645) or Shah et al ('893) or Beckstrom et al ('374) could include the use of any suitable communications link that would provide the communications required by the postage dispensing functions/operations of either Brookner et al ('790) or Shah et al ('738) or Kara ('739) or Gravell et al ('303) or Lee et al ('960) or Brasington et al ('406) or Sansone ('781) or Whitehouse ('945) or Heiden et al ('645) or Shah et al ('893) or Beckstrom et al ('374) without applicant providing evidence of expected results from using a particular type of communications link.

11. The examiner has cited prior art of interest, for example:

A) Sansone et al (4,837,701) which discloses as can be seen in fig. 3, a secured metering device (SMD) 25 that will down load postage over a network to a number of mail processing systems for example 37A, 39 & 40A for printing on items of mail.

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B) Abumehdi (5,508,933) which discloses the process following by accounting units in postage metering systems.

C) Bransten which discloses dispensing postage over the internet.

D) Carroll et al (6,470,327) which discloses a web based postage dispensing system.

12. The shorten statutory period of response is set to expire 3 (three) months from the mailing date of this Office action.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edward Cosimano whose telephone number is (703) 305-9783. The examiner can normally be reached Monday through Thursday from 7:30am to 6:00pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss, can be reached on (703)-308-2702. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1113.

13.1 The fax phone number for UNOFFICIAL/DRAFT FAXES is (703) 746-7240.

13.2 The fax phone number for OFFICIAL FAXES is (703) 872-9306.

13.3 The fax phone number for AFTER FINAL FAXES is (703) 872-9306.

07/13/04



Edward R. Cosimano
Primary Examiner A.U. 3629